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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/987,404

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Takeshi Kamio

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04/28/2011

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

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SUITE 200

VIENNA, VA 22182-3817

EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1741

MAIL DATE

DELIVERY MODE

04/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/987,404 | Applicant(s) KAMIO ET AL. | |
| | Examiner John Hoffmann | Art Unit 1741 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,10-15,17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,10-15,17 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/11/2011 has been entered.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The 'eccentricity error' of 0.4% of the independent claims is not mentioned in the specification. The specification only refers to an eccentricity of 0.4%.

As pointed out in **MPEP 608.01(o)**:

Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

As indicated below, it is known in the fiber art that a core can be eccentric, without any error.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-5, 7-8, 10-12, 14-15, 17 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the "eccentricity error" of 0.4%. It is noted that the application as filed refers to the 'eccentricity' with no mention of 'error'. Note for example Bachmann 5133794 which evidences that for some uses, core eccentricity is a desired result. It seems likely to Examiner that one can have a (designed) 20% eccentricity core, whose error (i.e. the eccentricity error) from that ideal is 0.3%. There is nothing that reasonably suggests that applicants had possession of this claimed feature of an error being less than 0.4%.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, 7-8, 10-12, 14-15, 17 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims refer to an 'eccentricity error', but it is unclear relative to what standard the error is. The specification as originally filed mentioned 0.4% eccentricity - but no mention of an error. One of ordinary skill would not be able to determine whether the claims should be interpreted as disclose (an eccentricity of 0.4%), or if it is to encompass a situation where ovality/eccentricity is desired (e.g. US Patent 5133794) and 0.4% errors relative to the desired eccentricity.

The preamble of claim 1 uses the language "to form a glass base material" and the last two lines of claim 1 refers to "a glass base material manufactured", however there is no explicit recitation that a glass based material is formed, or manufactured. It is also confusing if they are refer to two different glass base materials, since the first is formed, but the second is manufactured. Since different terms are used (formed vs. manufactured), such suggests they are not the same thing. *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72, 50 USPQ2d 1465 (Fed. Cir. 1999) (recognizing "the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope.").

Claim 8 is not understood because it refers to "a glass based material" at the last two lines, but no where is any glass base material provided for. This makes it unclear if this material is optional or required. Claim 15 is indefinite for the same reasons. And if it is optional, is unclear if the corresponding error is also optional.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1741

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-5, 7 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa 5306322.

See how Ishikawa was previously applied to the prior claims and affirmed by the BPAI on 2/15/2011. The present independent claims incorporate the limitation of claim 6 – the rejection of which was reversed by the BPAI, because Examiner only offered a conclusory statement lacking any credible reason or evidence.

Examiner now provides substantive reasoning: Examiner's dictionary offers a definition for error as: "the amount of deviation from a standard or specification". The term "eccentricity error" as well as "error" do not appear to have an art-recognized meaning. The present specification does not suggest that any special meaning was intended for either of these terms. Thus the plain meanings are used to interpret the claims. Examiner's dictionary also reports other (narrower) definitions for "error". However, the Office uses the broadest reasonable interpretation, thus any of the narrower scopes would not be appropriate.

It is noted that no standard or specification is indicated in the claims - thus it is deemed that the claims encompass any standard from which to determine an error. Examiner understands that most technical drawings/requirements are of the sort 1.250 ± 0.006 . That means any size from 1.244 to 1.256 is within tolerance and is acceptable. Such values would not be considered an error. But if the final product had

a size of 1.243 or less, or 1.257 or greater, such would be out of tolerance, unacceptable, and could be considered an error.

In the fiber art, one could easily envision that a fiber producer has eccentricity tolerances for core eccentricity. Such as less than 1% eccentricity, or less than 10% eccentricity. And thus any fiber outside this stated tolerance would be an error. It would have been obvious to not sell any fiber that has any error in it (i.e. outside stated tolerances), because clients would not trust a manufacturer who sold fiber outside of tolerance.

To put it another way: Based on col. 12, lines 5-8, Ishikawa creates a useable fiber. Whereas there may be some eccentricity, the degree/type/nature of eccentricity cannot be considered an 'error' because it does not result in a deviation from a standard.

Alternatively: Since no standard by which to measure the error is indicated, any standard can be used, including an arbitrary one. Thus one can pick and choose a standard for the Ishikawa preform, so that the calculated error is less than 0.4%

Still further: the last two lines of claim 1 are not explicitly tied back to the core, the 'manufactured' glass base material, sintering and of the steps. In fact, the 1 does not even recite that sintering occurs. Since the sintering of the last line of the claim is not connected to the other steps, it need not be the result of the other steps. More explicitly: applicant's use of 'manufactured' opens the scope of the limitation to included

manufacturing steps beyond those of the forming. That is: an intended use. The formed glass base material is such that it can be used to manufacture (using any steps) a glass based material with a error of 0.4% or less. See figures 5 and 6 of FLeming 5221306 which shows that one can alter eccentricity simply by removing cladding material from the appropriate places. It is clear that one can further manufacture Ishikawa, to tailor the eccentricity to any desired degree.

This is NOT to be interpreted as saying it would have been obvious to obtain the 0.4% error. Rather the Office's position is that claim 1 is very broad that it does not require any structure/article/material a 0.4% error. Rather the claim only requires the creation of the material which is capable of being further manufactured to have a 0.4% error.

The rest of the claims and limitations are clearly met for the reasons of record.

Claims 8, 10-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa 5306322 in view of Antos 6289698.

See how Ishikawa is applied above, and how Ishikawa and Antos were combined in the prior Office Action – as affirmed by the BPAI.

Response to Arguments

Applicant's arguments filed 3/11/2011 have been fully considered but they are not persuasive.

It is argued that since the BPAI found that Examiner failed to provide reasoning or evidence for the conclusion that the 0.4% limitation would have been obvious, that the claims that incorporate the limitation should therefore be allowable. It is noted that Applicant has not offered any rationale as to why this 0.4% limitation is an important feature –in the present arguments or in the Brief. Examiner's failure to provide his rationale is not a reasonable basis for allowing the present application. Thus rationale is provided above explaining why the claims fail to define over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Furuguchi is cited as being directed to the disclosed limitation of the eccentricity. Furuguchi is evidence that it was known to have core eccentricities of less than 0.4%.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Thursday, roughly 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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